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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/384,380	08/27/1999	MICHIHISA TASAKA	0234-0370P	7724

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EXAMINER

LEE, RIP A

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 02/21/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/384,380

Applicant(s)

TASAKA ET AL.

Examiner

Rip A. Lee

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7 and 10-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-3, 5-7 and 9-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

An amendment was filed on December 26, 2001. Claims 1 and 10-14 have been amended to correct matters of form. Claims 1 and 5 have been amended to include the subject matter of claims 4 and 8, both of which were subsequently cancelled. Priority documents have been received and have been entered into the record.

Election/Restrictions

1. The Applicants' election with traverse of invention I, claims 1-8 and 10-15 has been acknowledged. The traversal is on the grounds that no undue burden exists in a search for the inventions I and II. This is not found persuasive because the inventions I and invention II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the flame retardant material can be used alone without incorporating it into an optic fiber wire.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claim 15 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,929,165 to Tasaka *et al.* for the reasons set forth in the previous office action of August 23, 2001.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-3, 5-7, and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,929,165 to Tasaka *et al.* in view of U.S. Patent No. 5,221,781 to Aida *et al.* for the reasons set forth in the previous office action of August 23, 2001.

7. Claims 1-3, 5-7, and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tasaka *et al.* in view of U.S. Patent No. 6,218,454 to Nosu *et al.* for the reasons set forth in the previous office action.

Response to Arguments

8. The Applicants traverse the rejection of claim 15 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,929,165 to Tasaka *et al.*

The claims of the present invention recite component (d) as an ethylene/ α -olefin copolymer having a density of 0.91 g/cm³ or less that is synthesized in the presence of a single site catalyst. Tasaka *et al.* also disclose an ethylene/ α -olefin copolymer wherein the ethylenic component has a density of 0.88-0.94 g/cm³. It was indicated that the product-by-process language bears no patentable weight because the patentability of a product claim rests on the product formed, not on the method by which it is produced. *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

A declaration, purportedly demonstrating unexpected results, was filed on December 26, 2001 by Mr. Kazuhiko Kobayashi. The manuscript has been reviewed, but the data within are not deemed to be persuasive. First, unexpected results can not be a basis for patentability where a rejection under 35 U.S.C. 102 is involved. *In re Malagari*, 182 USPQ 549 (CCPA 1974).

Secondly, the Applicants maintain that a fire-retardant resin composition according to the present invention is unexpectedly superior with respect to mechanical characteristics and heat resistance as compared to prior art compositions. This is not the case. As shown in Kobayashi's Table 1, extension, tensile strength, heat deformation, horizontal flame test, and 60°-inclined flame test values are identical or comparable. There are no vast differences in mechanical or heat resistant properties to be noted.

The comparative example is rated poorly in terms of whitening characteristics, but this is an aesthetic feature not germane to fire retardance. Processing characteristics are shown to be poor for the comparative example. Again, this is not related to fire retardance. Furthermore, these data reflect properties of an electric wire, not the composition alone.

Finally, a single example does not prove that all single site catalysts generically claimed produce a useful ethylene/ α -olefin copolymer. A corollary to the above statement is that a single example does not disprove the possibility that other multi-site catalysts produce useful copolymers.

9. The Applicants traverse the rejection of claims 1-3, 5-7, and 10-14 under 35 U.S.C. 103(a) as being unpatentable over Tasaka *et al.* in view of U.S. Patent No. 5,221,781 to Aida *et al.* The Applicants' amendments to the claims do not obviate the teachings of the prior art.

10. The Applicants traverse the rejection of claims 1-3, 5-7, and 10-14 under 35 U.S.C. 103(a) as being unpatentable over Tasaka *et al.* in view of U.S. Patent No. 6,218,454 to Nosu *et al.* The Applicants' argument has been fully considered but it is not persuasive.

The Applicants indicate that the present application claims priority as of August 31, 1998 which precedes the U.S. filing date of the Nosu *et al.* patent of October 15, 1998. However, it is noted that Nosu *et al.* claims foreign priority to JP 9-303677 filed on October 17, 1997. Again, the Applicants' amendments to the claims do not obviate the teachings of the prior art.

11. In view of the discussions above, the rejections of record have not been withdrawn.

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12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9310. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

ral

February 14, 2002



DAVID W. WU
SUPERVISORY PATENT EXAMINER
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